

REMARKS

Pending Claims

Claims 1-10 are pending in this application. Claim 2 has been canceled. Claims 1, 4, 5, 8 and 10 have been amended. No new matter has been added.

Claim Rejections under 35 U.S.C. §103

Claims 1-4 stand rejected under 35 USC 103(a) as being unpatentable over Huberman, U.S. Patent No. 5,826,244 in view of Kinney et al., U.S. Patent No. 7,249,085, Shoham et al., U.S. Patent No. 6,285,989, Odom et al., U.S. Patent No. 6,058,379, and Koopersmith, U.S. Pregrant Publication No. 2001/0042002.

Claims 5-10 stand rejected under 35 USC 103(a) as being unpatentable over Huberman.

Applicants request reconsideration of the rejections for the following reasons.

Patentability of the Claims

The present invention concerning claims 1, 5 and 8 is characterized by an auction brokerage service provided by a brokerage computer that resides between a user terminal and a plurality of auction servers. The brokerage computer develops an auctioned commodity offered by the user to a plurality of auction operations conducted concurrently by the auction servers, coordinating the auction operations to bring the auction to a single result. Each auction server is a conventional auction brokerage computer which accepts bids from a plurality of

other user terminals.

Independent claims 1, 5 and 8 have been further amended to more specifically define Applicants' invention. Thus, claim 1 has been amended to recite transmitting an auction registration request in name of the user to each of the auction servers and further amended to define "gathering trade information of how the auction commodity has been bid for at the selected auction servers and tendering to the other auction sites, the highest tendered price of the bids in the name of a substitute in order to adjust the bid prices to the highest price over all the auction sites". Support for this additional amendment is found in the specification at page 5, lines 5-17 where it is stated as follows:

"Then, the auction site monitoring section 242 determines whether any buyer has been found at any auction site (step 522). If found, it compares tendered prices of all the auction sites at which the buyers have been found for such commodity to determine the highest tendered price (step 523). Then, it notifies other auction sites where the highest tendered price has not been found of the highest tendered price (step 524). Specifically, the auction site monitoring section 242 may place tenders with the highest tendered price to the other auction sites in the name of a substitute. For example, the identifier of the brokerage server 230 is used as the name of the substitute."

Similar amendments relating to tendering to the other auction computers the highest bid price in the name of a substitute have been made to claims 5 and 8.

The cited Huberman, Kinney et al., Shoham et al., Odom et al., and Koopersmith references are different and do not disclose a brokerage computer such as the present invention presents. They essentially only disclose the conventional type of auction servers.

Huberman, Shoham et al., and Odom et al. refer to "multiple auctions". This terminology, however, is regarded as an established one is "double auctions" in the field of

auction technology. Shoham et al., mentions the background on auction theory and practice, referring to an auction environment where there are multiple buyers and sellers (column 1, lines 35-64).

According to Huberman, "multiple auctions" means there are a plurality of independent auctions among multiple buyers and multiple sellers (column 18, lines 37-34). Each auction is conducted by a separate job, independent of other jobs (column 18, lines 42-43). Multiple auctions can be executed using multiple processes or a single process (column 7, lines 12-15).

The present invention is not associated with multiple independent auctions. It develops a single auction into a network of associated auctions conducted by the selected auction servers and coordinates the auction operations to bring the auction into a single unified result to be presented to the user. It is clear that the present invention does not handle "multiple auctions" in the sense that the cited reference refer to.

In the present invention, the brokerage computer registers the auctioned commodity at each of the auction servers with the name of the user who offers the commodity (specification page 12, lines 11-15); gathers trade information of how the auctioned commodity has been bid for the selected auction servers; and tenders to the other selected auction sites the highest tendered price of the bids in the name of a substitute (page 15, lines 13-16).

This action unifies the highest tendered price of all the auction sites at which the identical commodity is registered to avoid a problem in which the identical commodity might be knocked down at plural different prices (page 15, lines 20-23).

The brokerage computer receives the auction result from each auction site, and judges

whether or not it terminates the auctions under way in both the informing auction site and other auction sites depending on whether or not the trade has concluded with the substitute (page 16, line 22 to page 17, line 21).

Because the cited references do not teach the brokerage computer of the present invention, they fail to suggest it acting as a substitute who tenders to the other auction sites the highest tendered price of the bids.

Regarding claims 5 and 8, predicated on (1) the presence of a service provider or broker, (2) multiple auctions, and (3) various task performed by the broker, the Examiner has concluded that the present invention is obvious in light of the cited references. However, it is evident that the brokerage computer in the present invention is the one totally different from the conventional brokers these references disclose.

There is no suggestion or motivation in any of the cited Huberman, Kinney, Shoham, Odom and Koopersmith references as well as in the alleged “well known practices” of the prior art that would lead a person of ordinary skill in the art to combine their teachings in the manner done so by the Examiner to find the present invention as now claimed obvious.

It is submitted that the Examiner’s attempted combination of the five references and the alleged “well known practices” fail to raise a *prima facie* case of unpatentability. It has long been held that a Patent Examiner bears the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 USC §103. The mere fact that the reference cited by the Examiner may be modified does not allow the Examiner to meet his burden absent a suggestion in the cited art of the desirability of the modification. In order to find Applicants’

invention allegedly obvious, the Examiner has had to combine the teachings of five different references as well as the allege “well known practices”. In doing so, the Examiner has isolated features of each of the references and practices and attempted to combine them without any suggestions in any of the references and practices of such a combination.

It is difficult to fathom how one skilled in the art would find Applicants invention obvious when it requires five different references and additional prior art practice to allegedly arrive at Applicants’ invention. It is submitted the line between obviousness and invention is crossed well before combining this number of references and practices. The only thing believed to be obvious is that Applicants’ invention is patentable when this many references are relied upon.

To the extent that Applicants’ invention allegedly is obvious, it could only be obvious when viewed with the hindsight of Applicants’ teachings and would require a total reconstruction of the various cited references to arrive at Applicants’ invention.

As was noted by Federal Circuit in In re Fitch, 23 USPQ 2d 1780 (Fed. Cir. 1992), an Examiner may not “use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious”.

Moreover, even if some or all of the elements or steps in Applicants’ claimed combination may be old elements or steps known in the art, this does not necessarily negate invention. The invention must be looked at as a whole in determining patentability.

Relevant here is the opinion of the U.S. Court of Appeals for the Federal Circuit in In re Kotzab, 55 USPQ 2d 1313, 1316 (2000), wherein the court stated:

“Most if not all inventions arise from a combination of old elements... Thus, every element of a claimed invention may often be found in the prior art... . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention... . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation suggestion or teaching of the desirability of making the specific combination that was made by the Applicant... .”

It is therefore submitted that claims 1 and 3-10, as amended, are patentable.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants contend that the above-identified application is now in condition for allowance. Accordingly, reconsideration and reexamination are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. NIT-278).

Respectfully submitted,

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